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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,078	02/05/2002	Daniel M. Judge	13808-002001	7452
26161	7590	03/19/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			HOOLAHAN, AMANDA J	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/068,078	Applicant(s) JUDGE, DANIEL M.	
	Examiner Amanda J Hoolahan	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,5-8 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5-7,15-18,20,21 and 23-28 is/are rejected.
- 7) ☒ Claim(s) 8,19 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In view of the appeal brief filed on January 16, 2004, PROSECUTION IS HEREBY REOPENED. Please see rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3 and 5-7 are finally rejected under 35 U.S.C. 102(b) as being unpatentable by USPN 4,195,787 to Thomason.

Numerals A and B have been added to Figure 2 and numeral C has been added to Figure 6 in reference to certain components of the rolled product disclosed by Thomason. See copy attached at the end of this action.

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Thomason discloses a rolled product of continuous separable sheets, comprising at least a first (A) and second (B) contiguous separable sheet of product wound around an axis (C), forming a cylindrical roll, each sheet having an outer edge positioned parallel to the axis; at least the first and second contiguous separable sheet (A, B) of product (11) having at least one indicium (14) that bears a predetermined relationship when the first sheet is the outer most sheet of the rolled product (11), such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of each sheet having the indicium when the sheets are formed into a cylindrical roll, wherein the indicium is a continuous undulating indicium (14', see Figure 4) (column 1, lines 22-23); at least the first and second sheet of contiguous separable sheets (A, B) of product (11) have a plurality of indicium (14, D); the plurality of indicium are out-of-phase from each other; the continuous undulating indicium are sinusoid-shaped (See Figure 4) having a predetermined wavelength.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15-18, 20-21, 23-24 and 26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,282,807 to Johnson in view of Thomason.

Johnson discloses a rolled product wherein normal manufacture of the product comprises the method steps of making a roll of product with a mark for visually locating the end of the roll comprising marking the sheets with at least one visually perceivable mark extending the length continuously for the entire length of said roll, the visually perceivable mark bearing a predetermined relationship between the portion of the mark at the edge of the roll and the portion of the mark that lies directly beneath each edge when the product is spooled onto a roll, such that a discontinuity is likely formed between the mark at any edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located and spooling the product into a cylindrical roll; the indicium is printed on the sheets (column 6, lines 21-23).

Johnson does not disclose the rolled product to be a roll of contiguous separable sheets of product; marking the sheets with a plurality of marks; the plurality of marks being sinusoid-shaped; the sinusoid-shaped marks are out of phase from one another; the sheets being toilet paper; the sheets being paper toweling.

With respect to claims 15, 20-21, 23-24, and 26: Thomason discloses the rolled product, such as toilet paper (column 1, paragraph 1) and/or paper toweling (column 1, paragraph 1) as described above in paragraph 2 wherein normal manufacture of the device comprises the method steps of making a roll of contiguous separable sheets of product with a mark for visually locating the end of the roll comprising marking the sheets with at least one visually perceivable mark extending the length of each of the sheets, the visually perceivable mark bearing a predetermined relationship between the portion of the mark at the edge of each sheet and the portion of the mark that lies directly beneath each edge when the sheets are spooled onto a roll, such that a

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discontinuity is likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located and spooling the sheets into a cylindrical roll. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add perforations to the rolled product, disclosed by Johnson, to replace the serrated edge so the rolled product will be made of separable sheets, as taught by Thomason, in order for the rolled product to be more convenient for the user because they more easily tear off only as much product as needed without the risk of cutting themselves on the serrated edge or blade.

With respect to claims 16-18: Thomason discloses the rolled product as described above in paragraph 2 wherein normal manufacture of the device comprises the method steps of marking the sheets with a plurality of marks and the plurality of marks are each sinusoid-shaped and out of phase with one another (see Figure 4). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use sinusoid-shaped marks which are out of phase with one another, as taught by Thomason, instead of the mark, disclosed by Johnson, in order for the product to be more visually appealing while ensuring that a user will be able to see the indicating mark.

6. Claim 25 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson <sup>s 15-18, 20, 21, 23, 24, and 26</sup> and Thomason as applied to claim ~~20~~ <sup>25</sup> above, and further in view of USPN 4,076,121 to Clayton et al. [hereinafter Clayton].

Johnson and Thomason disclose the rolled product of contiguous separable sheets as described above in paragraph 5.

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Johnson and Thomason do not disclose the rolled product wherein the sheets are plastic bags.

Clayton discloses a rolled product being separable sheets of plastic bags. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the indicia disclosed by Johnson and Thomason with a rolled product comprised of separable sheets of plastic bags, as taught by Clayton, in order to determine the free end of the rolled product and since Johnson and Thomason already suggests that the indicia could be used with products manufactured in a rolled form (Thomason, column 1, lines 1-10).

7. Claim 27 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and Thomason as applied to claim<sup>s</sup> ~~20~~ <sup>15-18, 20, 21, 23, 24, and 26</sup> above, and further in view of USPN 6,221,211 to Hollenberg et al. [hereinafter Hollenberg].

Johnson and Thomason discloses a rolled product of contiguous separable sheets as described above in paragraph 5.

Johnson and Thomason do not disclose the rolled product wherein the mark is dyed on the sheets.

Hollenberg discloses a tissue product having a mark that is dyed on the sheets (17). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the indicia dyed on the sheets, as taught by Hollenberg, instead of imprinted, as taught by Johnson and Thomason, since the way that the indicia is added to the rolled product is considered to be nothing more than the use of one of numerous and well known alternate types of methods for adding marks that a person having ordinary skill in the art would

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have been able to provide using routine experimentation in order to permanently add the indicia on the rolled product.

8. Claim 28 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson <sup>§ 15-18, 20, 21, 23, 24, and 26</sup> and Thomason as applied to claim ~~20~~ above, and further in view of USPN 5,266,257 to Kildune.

Johnson and Thomason discloses a rolled product of contiguous separable sheets as described above in paragraph 5.

Johnson and Thomason do not disclose the rolled product wherein the indicia is embossed on the sheets.

Kildune discloses a rolled product having indicia (12) embossed onto the product. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the indicia embossed on the sheets, as taught by Kildune, instead of imprinted, as taught by Johnson and Thomason, since the way that the indicia is added to the rolled product is considered to be nothing more than the use of one of numerous and well known alternate types of methods for adding marks that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to permanently add the indicia on the rolled product.

#### ***Allowable Subject Matter***

9. Claims 8, 19, and 22 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



10. The following is an examiner's statement of reasons for allowance:

With respect to claim 8: The prior art does not disclose or suggest a rolled product of contiguous separable sheets wherein the sheets are of length L and the wavelength of each of the sinusoid-shaped indicium are substantially equal to L in combination with the remaining limitations of the claims.

With respect to claim 19: The prior art does not disclose or suggest a method of making a roll of contiguous separable sheets of product for visually locating the end of the roll, wherein the sheets are of length L and the wavelength of each of the sinusoid-shaped indicium are substantially equal to L in combination with the remaining limitations of the claims.

With respect to claim 22: The prior art does not disclose or suggest a rolled product of contiguous separable sheets wherein the plurality of visually perceivable marks are sinusoid-shaped with a wavelength equal to the length of each sheet in combination with the remaining limitations of the claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 3, 5-7, 15-18, 20-21, and 23-28 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

ajh  
March 2, 2004



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**CHRISTOPHER W. FULTON  
PRIMARY EXAMINER**

